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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,885	03/31/2004	Jerome R. Lenhard	87741LMB	5763

7590 11/29/2007  
Paul A. Leipold  
Patent Legal Staff  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

EXAMINER
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MARTINEZ, JOSEPH P

ART UNIT	PAPER NUMBER
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2873

MAIL DATE	DELIVERY MODE
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11/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/813,885	LENHARD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph Martinez	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-137 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-137 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of claims 37-137 in the reply filed on 7-30-07 is acknowledged. The traversal is on the ground(s) that the identical electrochromic material of claim 1 is required for the device of combination claim 37. This is not found persuasive and the previous Election/Restriction is vacated. However, upon further consideration, a new Election/Restriction is made as follows.

Claims 1 and 37 are generic to the following disclosed patentably distinct species:

- Species IA. Drawn to claims 2 and 74.
- Species IB. Drawn to claims 3 and 75.
- Species IC. Drawn to claims 4 and 76.
- Species ID. Drawn to claims 5 and 77.
- Species IE. Drawn to claims 6 and 78.
- Species IF. Drawn to claims 7 and 79.
- Species IG. Drawn to claims 8 and 80.
- Species IH. Drawn to claims 9-27 and 81-99.
- Species II. Drawn to claims 28-36 and 100-108.

Claim 37 is generic to the following disclosed patentably distinct species:

- Species IJ. Drawn to claims 38-48.

Species IK. Drawn to claims 49-60.

Species IL. Drawn to claims 61-73 and 124-129.

Species IM. Drawn to claims 109-123.

Species IN. Drawn to claims 130-137.

The species are independent or distinct because the differing limitations make the Species IA-IN patentably distinct from one another, i.e. a reference that anticipates or makes obvious one of the Species IA-IN would not, by itself, anticipate or make obvious any of the remaining invention.

Furthermore, if Species IH is chosen, applicant is required to elect a single disclosed species of Species IH:

Species IHa. Drawn to claims 10 and 82.

Species IHb. Drawn to claims 11 and 83.

Species IHc. Drawn to claims 12 and 84.

Species IHd. Drawn to claims 13 and 85.

Species IHe. Drawn to claims 14 and 86.

Species IHf. Drawn to claims 15 and 87.

Species IHg. Drawn to claims 16 and 88.

Species IHi. Drawn to claims 17 and 89.

Species IHj. Drawn to claims 18 and 90.

Species IHk. Drawn to claims 19 and 91.

Species IHi. Drawn to claims 20 and 92.

Species IHi. Drawn to claims 21 and 93.

Species IHm. Drawn to claims 22 and 94.

Species IHn. Drawn to claims 23 and 95.

Species IHo. Drawn to claims 24 and 96.

Species IHp. Drawn to claims 25 and 97.

Species IHq. Drawn to claims 26 and 98.

Species I Hr. Drawn to claims 27 and 99.

Species I Hs. Drawn to claims 28 and 100.

Species I Ht. Drawn to claims 29 and 101.

Species I Hu. Drawn to claims 30 and 102.

Species I Hv. Drawn to claims 31 and 103.

Species I Hw. Drawn to claims 32 and 104.

Species I Hx. Drawn to claims 33 and 105.

Species I Hy. Drawn to claims 34 and 106.

Species I Hz. Drawn to claims 35 and 107.

Species I Haa. Drawn to claims 36 and 108.

The species are independent or distinct because the differing limitations make the Species IHa-IHaa patentably distinct from one another, i.e. a reference that anticipates or makes obvious one of the Species IHa-IHaa would not, by itself, anticipate or make obvious any of the remaining invention.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with

this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Due to the complexity of the election/restriction, no telephone call was made to request an oral election to the above restriction requirement.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the

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record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph P. Martinez whose telephone number is 571-272-2335. The examiner can normally be reached on M-F 7:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Joseph Martinez/  
Patent Examiner, AU 2873  
11-25-07